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In re Application of
DESINGER et al.
Application No.: 10/564,322
Filed: June 26, 2006
Attorney Docket No.: 3444
For: SURGICAL PROBE

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(3), filed July 27, 2009 to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional and international applications set forth in the amendment filed concurrently with the instant petition.

The petition is DISMISSED.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional and international applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) and (3).

An amendment adding a reference to the prior-filed nonprovisional and international applications to the first sentence of the specification following the title has been included in a concurrently filed amendment. However, the benefit claim is not proper since it identifies a Patent number (U.S. Pat No. 6,723,094), instead of the U.S. serial number (USSN 09/868,303).

As to item (3), a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional is required. Here, applicant states "[T]he Entire delay between the date the claim was due under 37 CFR.1.78(d)(4) and the date the claim was filed was unintentional." Applicant's statement refers to 37 CFR 1.78(d)(4), not 37 CFR 1.78(a)(2)(iii). Therefore, a new statement is required.

Therefore, before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required. Additionally, a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional is required.

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